



PATENT
Attorney Docket No. 05725.0833
Customer No. 22,852

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Véronique DOUIN et al.

Application No.: 09/766,403

CPA Filed: January 22, 2001

For: NANOEMULSIONS COMPRISING AT LEAST
ONE AMPHIPHILIC LIPID, AT LEAST ONE OIL,
AND AT LEAST ONE NONIONIC POLYMER,
AND USES THEREOF

) Group Art Unit: 1617

) Examiner: L. Wells

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 1.193

Pursuant to 37 C.F.R. § 1.193, Appellants present in triplicate their Reply to the Examiner's Answer dated February 12, 2004. If any fees are required in connection with the filing of this paper, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

REMARKS

I. Grouping of Claims

In the Examiner's Answer the Examiner asserts that she does not agree with "appellant's statement in the brief that certain claims do not stand or fall together...." Examiner's Answer at 2. The Examiner agrees that the subject matter of the sets of claims

as grouped by Appellants are not patentably distinct and that Appellants present no different arguments for each group of claims. Id. Appellants disagree, and submit that the Examiner is improperly dismissing limitations recited in the dependent claims that further distinguish the claimed invention from the prior art.

In accordance with 37 C.F.R. §§ 1.192(c)(7) and (8), Appellants have stated that the claims do not stand or fall together, divided the claims into groups, and set forth arguments for each grouping of claims explaining why it is believed these claims are separately patentable over the prior art relied upon by the Examiner. By arguing that the claims stand or fall together, the Examiner has chosen to gloss over the limitations recited throughout the dependent claims, as well as Appellants' arguments for separate patentability over the prior art. Appellants submit that the Examiner's position is therefore improper, and request that the claims be grouped as set forth in the Appeal Brief.

II. Status of Rejections

In response to the Appeal Brief filed October 30, 2003, the Examiner has maintained the rejection of claims 1-9, 11-21, 23-25, 30, 33, 50, 51, and 55-84 under 35 U.S.C. § 103(a) as being unpatentable over U.S. 5,925,341 ("Cervantes") in combination with WO 99/36047 ("WO '047").

III. Response to Examiner's Arguments in the Answer

The Examiner maintains the rejection of claims 1-9, 11-21, 23-25, 30, 33, 50, 51, and 55-84 under 35 U.S.C. § 103(a). Appellants maintain that a prima facie case of obviousness

has not been established for the reasons set forth in the Appeal Brief filed October 30, 2003, as well as for those below.

The Federal Circuit has held that there must be clear and particular evidence in the prior art of a motivation or suggestion to combine the teachings of the cited references in the manner proposed by the Examiner. As explained by the Federal Circuit, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Further, as argued in the Appeal Brief, an Examiner can meet the burden of establishing a *prima facie* case of obviousness "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (internal citations omitted) (emphasis added); see also *In re Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

A. No motivation to combine references

In the present case, the Examiner has committed the legal error that the Federal Circuit warned against: she has not explained, using clear and particular evidence, how or why one skilled in the art would have been motivated to modify Cervantes with WO '047 to achieve the claimed invention. As discussed previously on the record, the Examiner has not

pointed to any actual, objective evidence of record that would have led one of ordinary skill in the art to expect the feasibility or utility of a combination, such as suggested by the Examiner.

Appellants maintain that the Examiner has not demonstrated why one skilled in the art would have been motivated to use the polyether-polyurethane polymers of WO '047 in Cervantes' emulsion, particularly because the polymers used in WO '047 are used in an aqueous hair dye, whereas the environment in Cervantes is an oil-in-water emulsion. One skilled in the art would not have been motivated to combine these references at least because of this important difference.

In rebuttal, the Examiner states that "both compositions have continuous water phase. An oil-in-water nanoemulsion is an aqueous dispersion of the nanoparticles of oil globules." Examiner's Answer at 6. The Examiner has apparently missed the point. It is precisely the presence of the oil globules that make the system fundamentally different from a strictly aqueous solution. The oil-in-water nanoemulsion has different properties than an aqueous solution, even if the oil is dispersed aqueously. This difference cannot be ignored, and one skilled in the art would recognize that a component cannot merely be plucked from one type of system and used in another type of system.

Further, in citing *In re Keller* (see Examiner's Answer at 5), the Examiner has misapplied the law. The Examiner states that test for obviousness "is what the combined teachings of the references would have suggested to those of ordinary skill in the art." Examiner's Answer at 5. The Federal Circuit recognizes, however, that virtually all inventions are combinations of old elements.

[A]n examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.

Yamanouchi Pharm. Co. , Ltd. v. Danbury Pharmacal, Inc., 231 F.3d 1339 (Fed. Cir. 2000). Thus, the Examiner's characterization of the claimed invention as merely a combination of known elements cannot serve as a basis for rejection.

When an Examiner relies on a combination of references, she can satisfy the burden of showing obviousness "only by showing some objective teaching [*leading* to the combination]." *In re Dembiczak*, 175 F.3d 994 at 999 (emphasis added). In the present case, the Examiner has not satisfied this burden, as argued previously on the record.

Finally, the Examiner regards claims 70-84 as not separately patentable because independent claims 70 and 73 recite the "same structural limitations of the nanoemulsion of claim 1." Examiner's Answer at 7. The Examiner apparently fails to consider that the dependent claims specifying, for example, an intended use may be important given the other limitations of the claim. For instance, the fact that the embodiment recited in claim 70 is for topical use may be an important characteristic of that embodiment, given that the nanoemulsions comprising oil globules in the compositions of claim 70 must have an average size of less than 150nm. Similarly, the process claims (claims 75-79) enjoy separate patentability because the Examiner has not shown how the cited references teach or suggest every claimed element, as she must do for each claim that stands rejected.

Appellants thus maintain that the Examiner has not demonstrated the requisite motivation to combine the teachings of the cited references.

B. The combined references do not provide a reasonable expectation of success in the proposed modification

As argued before, the Examiner has not shown why one skilled in the art would have had a reasonable expectation of success in the proposed modification. Even if the references were combined, the disparity in the type of environment in the references, as discussed on the record and above, would prevent one skilled in the art from reasonably concluding that a viable combination would result. The Examiner has failed to provide any evidence to show why one of ordinary skill in the art would have reasonably expected a successful cosmetic to be formed from the proposed modification. Neither reference suggests the success of the proposed combination, and one of ordinary skill in the art would not have had the reasonable expectation of success for making the modification proposed by the Examiner.

Further, as argued previously, WO '047 does not describe a nanoemulsion, as is claimed. Thus, even if one were to take the polyether-polyurethanes out of their aqueous environment in WO '047 and put them into the oil-in-water emulsion described in the '341 reference, there is no indication that the resulting combination would be a stable, cosmetically viable nanoemulsion. One of ordinary skill in the art, generally knowing that the cosmetic art is unpredictable and specifically recognizing the incompatibilities between aqueous and oil-in-water compositions, would not have reasonably expected success based on the substitution that the Examiner suggests.

IV. Conclusion

For the foregoing reasons, and the reasons of record, the Examiner's rejection of the claims is improper and should be withdrawn. Appellants respectfully request that the rejection be reversed and withdrawn.

Please grant any extensions of time required to enter this brief and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW GARRETT & DUNNER, L.L.P.

Dated: April 8, 2004

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